

PATENT Docket GE131915

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MAY 03 2005**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****Applicant:**
E.M. Even et al**Art Unit:** 1725**Application No.:** 10/651,678
Confirmation No: 9311**Examiner:** Heinrich, S.**Filed:** 08/29/2003**Title:** LASER SHOCK PEENING TARGET**PROVISIONAL ELECTION**Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the office action dated as mailed on 04/26/05, and having a period of response extending through and including 05/26/05, Applicants provisionally elect, with traverse, the Group I invention as designated by the examiner, presently including claims 1-21.

Applicants traverse the restriction requirement as failing to meet the MPEP requirements.

Claims 1-21 are product claims and not apparatus claims as designated by the examiner. And, claims 22-24 recite methods for using the recited products.

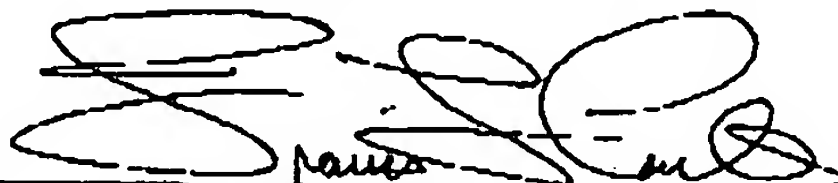
The applicable MPEP provision is therefore 806.05(h); and claims 22-24 were written as dependent claims under the mandate of MPEP 821.04, which requires rejoinder upon allowance of the claims from which they depend.

CERTIFICATE OF TRANSMISSION (37 CFR 1.8a and MPEP 512)

I hereby certify that this 3-PAGE correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office at Fax No. 703-872-9306 on the transmission date indicated below.

FRANCIS L. CONTE

(Name of person transmitting paper)



(Signature of person transmitting paper)

3 May 2005

(Date)

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The examiner's characterization of apparatus and apparatus for its practice fails to meet the requirements of the MPEP including MPEP 806.05(e); and distorts the significance of these claims.

The examiner states that "the apparatus can be used for welding or for joining or for drilling instead of the instant claimed marking [claim 22] and peening [claim 24]."

However, this is incorrect, and without logic.

Independent claim 11, from which claims 22-24 depend, recites a laser target 26, which is an assembly of the two wedges 30,32 on the common shank 28.

In claim 12, the wedges have seats 40 for supporting a target sheet 42.

The resulting laser target 26 is illustrated in figure 5 for use in initially aligning the laser 20 for laser shock peening the workpiece 16.

The examiner contends, without evidentiary support or logic, that the target 26 recited in method claims 22-24 can be used "for welding." But how?

The target 26 has no welding capability, there is nothing to weld in the target 26 since it is an assembly of parts.

The examiner's contention of "instead of the instant claimed marking and peening" is irrelevant to the recited target.

The target does not mark anything, but it is used for alignment when the target sheet 42 is mounted therein.

The target does not peen anything; it is only used to align the laser.

The examiner contends in the alternative that the recited target can be used for "joining," but, yet again, the target cannot effect any such "joining" since it is a mere target for the laser beam.

The examiner lastly contends that the target can be used for "drilling," but, yet again, the target has no "drilling" capability since it is a mere target.

It should be noted that if method claims 22-24 are the

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subject of a divisional application, examination of those claims must necessarily repeat the examination of the target claims from which they depend. This is additional evidence that those method claims are not independent and distinct inventions, since, quite clearly, they expressly are dependent from the target claims of Group I.

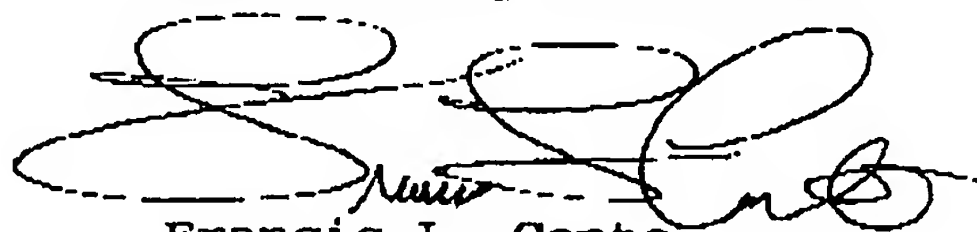
It appears that the different requirements of MPEP 806.05(e) and 806.05(h) are causing confusion as to the proper designation of the laser targets recited in the claims and their method of use.

Accordingly, should the examiner persist in the restriction requirement, Applicants hereby request that the examiner further explain his interpretation of "apparatus," "product," and corresponding process of use or practice, and cite the applicable MPEP provisions in support thereof.

Furthermore, the examiner is also requested to further explain how it would be even possible to use the recited laser targets "for welding or for joining or for drilling," and provide examples thereof which would be understood by one skilled in the art.

Accordingly, withdrawal of the restriction requirement is warranted and is requested.

Respectfully submitted,



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Date: 3 May 2005

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